



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

C

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,664	08/29/2003	R. Magdina		7782
<div>Ely Zborovsky Patent Bureau 6 Schoolhouse Way Dix Hills, NY 11746</div>				
7590		09/06/2007	<div>EXAMINER SANDERS, KRIELLION ANTIONETTE</div>	
			<div>ART UNIT 1714</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 09/06/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,664

Applicant(s)

MAGDINA ET AL.

Examiner

Kriellion A. Sanders

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 24-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16 and 24-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wainwright et al, US Patent No. 5,532,292. Wainwright et al discloses coating compositions such as paints that comprise a binder, colorant, melamine, ammonium phosphate, pentaerythritol, blowing agent and charring agent. Fibrous fillers and additives may also be used. When the dry mixture of components are formulated into a wet coating composition, the amounts of components overlap with those amounts claimed by applicant. See cols 4 and 5. The act of providing a surface with a paint formulation generally perceived as painting. This process step is considered to be anticipated and/or obvious in view of the patented disclosure. The presently claimed invention presents nothing of a novel nature.

See the abstract, col. 1, lines 31-60, col. 3, lines 29-34, col. 4, lines 21 through 59 and col. 5, lines 8-56.

Previously, applicant argued that the invention of Wainwright is not from the same field of endeavor as applicant's invention. This argument is not persuasive because Wainwright indicates that the intumescent compositions of the patented invention may be incorporated into paints. See lines 6-9 of the abstract. Since the components of the intumescent composition of Wainwright et al are essentially the same as applicant's, the present claims are considered to be met by Wainwright et al or at least rendered obvious there over.

4. Applicant's previous argument that Wainwright et al has nothing to do with strengths and weaknesses of previous paints is not understood, since this argument is based upon features that are not included in the present claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., advantageous improvement in strength of present paints over prior art paints) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's argument that Wainwright does not disclose any information about the problems with the paints that took place before the present invention does not negate the fact that the components of the presently claimed invention are clearly included within the patented invention. Therefore the present invention directed to paints, a method of formulating paints and a method of painting is obvious if not fully anticipated by Wainwright. Applicant is advised that the process steps of "providing" the components and "painting" the surface of a substrate are

Art Unit: 1714

obvious process steps to the ordinary practitioner in the painting field. These steps are self-explanatory.

Applicant's limitations as set forth in claims 5, 13 and 28 are met by Wainwright et al at col. 1, lines 50-61 wherein the amount of film-forming binder, solvent and pigment are suggested to be adjusted within the prescribed limits so as to result in 15% or less by weight of intumescent or flame retardant composition.

Response to Arguments

5. Applicant's arguments filed 6/25/07 have been fully considered but they are not persuasive.

6. Applicant argues that, "In the inventive paint there are components which are taken at different amounts than in the Wainwright patent, and therefore the differences in the amounts of the components should be considered as patentably differentiating the present invention from the prior art represented by this reference". Applicant does not indicate specifically which amounts of which components are not met by the references. Upon reconsideration the patented invention does appear to meet the amounts of components set forth in applicant's claims.

7. Applicant further argues that the claim related to the process of painting is different since it is performed with a different paint and that the patent to Wainwright is not from the same field of endeavor. While it is true that the intumescent compositions may be incorporated into the paint, this reference does not disclose a paint, the method of painting and the method of producing a paint, which are similar to the applicant's invention. This argument was addressed in the previous office action and the response is repeated above.

Claim Rejections - 35 USC § 103

Claims 1-16 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wainwright et al., US Patent No. 5,532,292 in view of Pirig et al, US Patent No. 6,251,961.

Applicant's limitations as set forth in claims 7, 15 and 29 and 30 are obvious over Wainwright et al in view of Pirig et al. Pirig et al equates melamine and ***ammonium polyphosphate***. Pirig et al discloses that it is known that melamine and ***ammonium polyphosphate*** react in aqueous solution releasing ammonia (NH₃). At increased temperature and increased humidity this reaction can also take place in a dried flame-retardant ***coating*** which forms an insulating layer, thus reducing the flame-retardant properties of the ***coating***. See the paragraph bridging cols.1 and 2 of Pirig et al. Also see Wainwright et al at col. 1, lines 50-61 wherein the specific amounts of melamine and pentaerythritol are suggested to be adjusted within the prescribed limits so as to result in weight percentages of the total paint composition that overlap with those of applicant's claims. Therefore, incorporation of melamine, melamine polyphosphate and pentaerythritol at the weight percentages prescribed by Wainwright et al would have been obvious to the ordinary practitioner of this art at the time of applicant's invention. Applicant has shown nothing of an unobvious nature by using such weight percentages for these specific components.

Response to Arguments

8. Applicant's arguments filed 6/25/07 have been fully considered but they are not persuasive. Applicant states that the rejection of the claims over the combination of the references should also be considered as not justified. Applicant argues that the patent to Pirig does not disclose all elements of the paint of the present invention, and therefore its combination

Art Unit: 1714

with the patent to Wainwright would not lead to the paint in accordance with the present invention nor will it lead to a method of painting or method of producing the paint. In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1714

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kriellion A. Sanders
Primary Examiner
Art Unit 1714